REMARKS

Applicants thank the Examiner for rejoining claims 6 and 12 and examining them on the merits.

Claims 1, 2, 4, 7, 8 and 10 stand rejected under 35 USC 103(a) on Taniguchi. The crux of the Examiner's reasoning, as can be seen from the paragraph bridging pages 3 and 4 of the Action is that, although she admits that Taniguchi teaches lactic acid contents only in the range of 28-35 wt%, citing Table 6 in column 18, lines 20-35, and not the claimed lactide content, it would have been obvious to optimize the amount of lactide to achieve the desired mix of properties absent a showing of unexpected results. This rejection is respectfully traversed.

The question to be asked as to this rejection is whether the Examiner has provided an adequate factual basis from which the Examiner can reasonably conclude that persons of ordinary skill in the art had a reason to arrive at the maximum ***lactide*** content of the claimed invention based on the ***lactic acid*** contents Taniguchi in fact discloses. Applicants respectfully submit that the Examiner has not done so. In fact, the Examiner has made a systematic error in equating lactic acid content to lactide content. Only in hindsight, knowing of the 15 wt% maximum lactide content of applicants' claimed electret medium material, can one argue that reducing Taniguchi's alleged minimum lactic acid content to lactide content that is a mere 54% of that value would have been obvious. In particular, there is nothing in this record to support the Examiner's statement that it would have been "optimize" Taniguchi's lactic acid content so as to arrive at the lactide content of claimed invention, at least for the reason that Taniguchi does not discuss lactide content as claimed.

The recently-issued examination guidelines based on the *KSR* case provide a useful underpinning to the analysis. As explained at 72 Fed. Reg. 57527:

> In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably been expected to be able to do in view of that knowledge.

This does not relieve the Examiner of the duty to explain *why* the invention would have been obvious in light of the prior art. *Id.* at 57528. The rejection fails because, simply put, Taniguchi, the only evidence cited by the Examiner in support of this rejection, does not even hint at, let alone provide a reason to perform, the alleged optimization that the Examiner considers would have resulted in the claimed invention. This invention is not a combination of known elements even under the Examiner's view of the art.

First, the Examiner refers to Table 6 of Taniguchi as disclosing a lactide content of 28 to 35%. This table reports three non-woven fabrics containing 35, 28 and 31 wt% of a "low temperature thermoplastic lactic-acid base polymer filament." This must be where the Examiner finds an alleged teaching of 28 to 35 wt% lactide content. However, the remainder of each fabric is a "lactic acid-base polymer filament." Both filaments contain lactic acid, so there is no basis in Table 6 of Taniguchi for the Examiner's finding that it teaches a total fabric lactide content of 28 to 35 wt%. Table 6 does not tell anyone what the total lactide (as opposed to lactic acid) content of its fabrics happen to be. Persons of ordinary skill in this art know that "lactide content" and "lactic acid content" are not the same; Taniguchi recognizes this in column 5, lines 19-55, by explaining how lactic acid polymers are made by polymerizing lactides. Taniguchi says nothing whatever about the lactide, which would be a residual monomer, as opposed to lactic acid, content of its fabrics. In the words of the *KSR* guideline, Taniguchi does not show that a person "would have reasonably been expected to be able to [produce the low lactide content of applicants' invention] in view of that knowledge."

Second, there is nothing whatever in Taniguchi that would have given a person of ordinary skill in the art any reason to have made fabrics having as small a lactide content as is claimed. Without knowing about applicants' invention, a person of ordinary skill in the art would not have even looked at Taniguchi in the manner asserted by he Examiner and could not have seen any reason to reduce lactide content, a characteristic not even mentioned by Taniguchi, to the claimed level. The legal construct based on *In re Aller* on which the Examiner relies does not work unless persons of ordinary skill in the art would have known the allegedly optimizable

variable to be result-effective. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). That is, the record has to show that there would have been a reason for a person of ordinary skill in the art to optimize the variable in question for the optimization to have been obvious. The Examiner refers to a "desirable balance of properties" yet fails to point to anything in the record or elsewhere to identify those properties or how any person of ordinary skill in the art would have had a reason from Taniguchi to provide electret media having the low lactide content claimed. There is no evidence to support the Examiner's optimization theory.

Finally, the specification of this application provides evidence that the low lactide content claimed produces advantageous stability over time. See, page 24, line 23, to page 25, line 6. The prior art does not hint at this advantage.

For these reasons, Taniguchi does not support the obviousness rejection of claims 1, 2, 4, 7, 8 and 10, which should be withdrawn.

All of the remaining rejections rely on the Examiner's use of Taniguchi and should be withdrawn because Taniguchi does not provide the teachings for which it is relied.

Early action allowing claims 1, 2, 4-8 and 10-14 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 427972000600.

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